

II. REMARKS/ARGUMENTS

This is a response to the Office Action of February 18, 2005. Claims 1-5 and 7-20 are pending in the application. Claims 1, 12 and 19 are independent claims. The Office Action of February 18, 2005 is the third non-final Office Action in the history of this application.

In the first Office Action, mailed December 23, 2003, the Examiner rejected claims 1-5, 8-16, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 5,758,023 issued to Bordeaux (hereinafter "*Bordeaux*"), U.S. Patent No. 6,016,470 issued to Shu (hereinafter "*Shu*"), the Selounai publication entitled "Recognition of Arabic Phonetic Features Using Neural Networks and Knowledge-Based System: a Comparative Study" (hereinafter "*Selounai*"), U.S. Patent No. 5,953,701 issued to Neti (hereinafter "*Neti*"), U.S. Patent No. 6,546,369 issued to Buth (hereinafter "*Buth*"), and U.S. Patent No. 6,490,557 issued to Jeppesen (hereinafter "*Jeppesen*").

Further in that first Office Action, the examiner indicated that dependent claims 6 and 7 contain allowable subject matter when combined with independent claim 1.

Independent Claims 1, 12 and 19 have since been amended to incorporate the allowable subject matter of claim 6.

In the second Office Action, mailed June 21, 2004, the Examiner entered the amendments responsive to the first Office Action, and made no further rejections under 35 U.S.C. § 103(a). Instead, the Examiner rejected claims 1-20 under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement, and rejected claim 4 under 35 U.S.C. § 112 second paragraph for indefiniteness.

In response to the second Office Action, claims 1, 4, 12 and 19 have been amended to comply with the enablement and definiteness requirements of 35 U.S.C. § 112.

In this third Office Action, the Examiner has rejected claims 1-4, 12-14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu*, and in further view of U.S. Patent No. 5,930,754 issued to Karaali (hereinafter "*Karaali*"). The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and in further view of *Selounai*. The Examiner has rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and further in view of *Neti*. The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and further in view of *Buth*. The Examiner has rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and further in view of *Selounai*. The Examiner has rejected claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and further in view of *Jeppesen*. The Examiner has rejected claims 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and further in view of *Selounai*. Finally, the Examiner has rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and *Karaali*, and further in view of *Buth*.

Further in the third Office Action, the Examiner objected to claim 7 as being dependent upon rejected base claim 1, but indicated that claim 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

A. Rejections under 35 U.S.C. § 103(a)

As a procedural matter, it is noted that in the second Office Action there were no rejections under 35 U.S.C. § 103(a) of any of the claims that had previously been rejected under 35 U.S.C. § 103(a) over various combinations of six references. Under 37 CFR § 1.104, "examination shall be complete with respect both to compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with

respect to matters of form, unless otherwise indicated."¹ Since the amendments in response to the first Office Action were entered, and since the second Office Action contained no rejections under 35 U.S.C. § 103(a), it can be presumed that the claims as amended in response to the first Office Action had overcome the rejections under 35 U.S.C. § 103(a). Now, after clearly satisfying the rejections under 35 U.S.C. § 112 that were made in the second Office Action, the Examiner has again rejected the claims under 35 U.S.C. § 103(a) over various combinations of the same six references as in the first Office Action, but has added a seventh reference to each of the rejections under 35 U.S.C. § 103(a), implicitly arguing that by including the seventh reference, the claims are suddenly rendered obvious.

On its face, such a contention is tenuous, i.e. that a seventh reference, one that had escaped the Examiner's notice in two prior Office Actions, is the one reference that serves to render all of the claims obvious. Furthermore, adding a seventh reference in a third Office Action, in an attempt to breathe life into an obviousness rejection that had previously been overcome, smacks of piecemeal examination, which should be avoided as much as possible.²

The Examiner bears the initial burden of establishing a *prima facie* case of unpatentability. In the present case, this burden requires the Examiner to establish a *prima facie* case concerning the existence in the prior art of claim elements that the Examiner recognizes are missing from *Bordeaux*. Specifically, to establish a *prima facie* case of obviousness, there must be some evidence of a suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art to modify the reference.³ Where the

¹ 37 CFR § 1.104(a)(1).

² MPEP 707.07(g).

³ MPEP 706.02(j). *See also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (explaining that the teachings or suggestion to make the claimed invention must be found in the prior art and not based upon the Applicant's disclosure.)

references cited by the examiner fail to show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references," the Examiner has not carried the burden of establishing a *prima facie* case of unpatentability.⁴ Where the Examiner fails to establish a *prima facie* case, the rejection is improper and shall be reversed.⁵

The present invention involves systems and methods for acoustic transcription of speech using an orthographic system comprising a compact set of phonetics. The three pending independent claims — claims 1, 12 and 19 — include variations of the common element of a compact model for acoustically transcribing a language. As claimed, the compact model for acoustically transcribing a language includes a compact set of phonetic alphabets. As previously presented, the compact model for acoustically transcribing a language of the present invention, and specifically the claimed compact set of phonetic alphabets includes a reduced text-to-speech phonetics set.

In this case, the Examiner attempts for the second time in three Office Actions to combine and to render various dependent claim elements obvious. It is well settled that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." Although the suggestion to achieve the claimed invention may be found either explicitly or implicitly within the references themselves, there must be some evidence that the skilled artisan would select certain elements from the prior art references and combine them in the manner claimed.⁶

⁴ *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988).

⁵ *Id.*

⁶ *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372, 56 U.S.P.Q.2d 1065, 1073 (Fed. Cir. 2000) (holding that without specific evidence to modify the teachings of prior art references, the obviousness determination, based upon such modified references, is improper).

That is, generalizations about the specific teachings of references are insufficient to support a determination of obviousness.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the reference."⁷ In other words, the prior art *itself* must suggest the desirability of the modification.⁸ Here, the Examiner has pointed to no particular teaching, suggestion or motivation in *Bordeaux*, *Shu*, *Karaali*, *Selounai*, *Neti*, *Buth* or *Jeppesen* to accomplish acoustic transcription of speech using an orthographic system comprising a compact set of phonetics. Furthermore, the Examiner has pointed to no teaching in the cited references of a system for acoustic transcription of speech that includes a compact set of phonetics. Only in this, the third Office Action, the Examiner has introduced the argument that *Karaali* would have been obvious to combine with each of the prior art references "so that the storage requirements would not exceed the feasibility of most applications."⁹ However, the Examiner pointed to no teaching in any of the cited references that teaches, states or implies a need for a reduced text-to-speech phonetics set to prevent the storage requirements from exceeding the feasibility of most applications in a system for acoustic transcription of speech. Furthermore, even the combination of *Karaali* with any or all of the previously cited six references does not disclose a reduced text-to-speech phonetics set that includes the claim element where a phonological unit, a phonetic unit, or an identified variation in a language is removed. Accordingly, Examiner's rejection of the claims of the present invention as obvious over the cited references is improper.

⁷ *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q.2d 1125, 1127 (Fed. Cir. 1984).

⁸ *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 U.S.P.Q.2d 1021, 1024 (Fed. Cir. 1984).

Moreover, when determining the issue of obviousness, the Examiner must consider the claimed invention *as a whole*. In other words, the Examiner cannot use hindsight reconstruction to render the present invention obvious. The fact that the Examiner first had to pick and choose discrete portions from each of *six* different references to render the claims of the present invention obvious, and then add a *seventh* reference when obviousness based on six references was overcome, shows that the invention could not have been even remotely obvious to a person of ordinary skill in the art at the time the invention was made. That is, the Examiner used the Applicant's disclosure as a blueprint to render the present invention obvious. Such hindsight reconstruction is certainly improper.¹⁰ Accordingly, all pending claims are patentable.

(continued...)

⁹ See February 18, 2005 Office Action, p. 5.

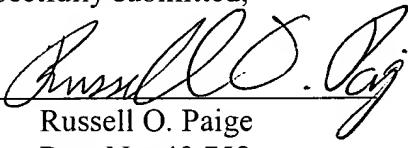
¹⁰ *In re Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1457.

III. CONCLUSION

The claims having been amended to overcome the Examiner's rejections under both 35 U.S.C. § 103(a) and 35 U.S.C. § 112, Applicant respectfully requests reversal of the rejection of claims 1-20 under 35 U.S.C. § 103(a), and asks that the claims promptly be permitted to issue.

Respectfully submitted,

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